

REMARKS

A. 35 U.S.C. § 102

1. Claims 1-5

In the Office Action mailed on August 6, 2004, claims 1-5 were rejected under 35 U.S.C. § 102(b) as being anticipated by Holstein. Applicants traverse the rejection. In particular, claim 1 recites aligning a scale element parallel to a measuring direction via an adjustment device. In contrast, Holstein discloses a scale 8 that has one end fixedly attached to housing member 1 via support arm 9' and pin 10 (Col. 2, l. 66 to Col. 3, l. 1). The other end of the scale 8 is connected to a pin 15 and support arm 14. The support arm 14 is moved via lever 12 so as to expand the scale 8 (Col. 3, ll. 6-25). The support arm 14 does not align the scale element 8 parallel to the measuring direction. Accordingly, claim 1 is not anticipated by Holstein and so the rejection is improper and should be withdrawn.

The rejection should be withdrawn for the additional reason that Holstein does not disclose providing an adjustment device that is movable in the measuring direction and that is provided on a body that has a scanning head provided thereon. The support arm 9' does not move and the support arm 14 is provided on a pin 14' that does not support the sensing unit 4 thereon. Accordingly, claim 1 is not anticipated by Holstein and so the rejection is improper and should be withdrawn.

The rejection should be withdrawn for the additional reason that Holstein does not disclose providing an adjustment device that does not cooperate with a scale element at a position of rest. As explained above, the support arm 9' and the support arm 14 are each coupled at all times to the scale 8 via a pin 10, 15, respectively. Thus, the support arms 9' and 14 each

cooperate with the scale 8 at all times. Accordingly, the rejection should be withdrawn.

2. Claims 6-14

Claims 6-14 were rejected under 35 U.S.C. § 102(b) as being anticipated by Holstein. Applicants traverse the rejection. In particular, claim 6 recites an adjustment device that “causes said scale element to be aligned on said installation face parallel with respect to said measuring direction.” As pointed out above in Section A.1, Holstein’s support arm 14 does not align the scale element 8 parallel to the measuring direction. Accordingly, claim 6 is not anticipated by Holstein and so the rejection is improper and should be withdrawn.

The rejection should be withdrawn for the additional reason that Holstein does not disclose providing an adjustment device that is movable in the measuring direction and that is provided on a body that has a scanning head provided thereon. This was pointed above in Section A.1. Accordingly, claim 6 is not anticipated by Holstein and so the rejection is improper and should be withdrawn.

B. New Claim 15

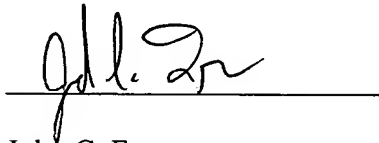
New claim 15 depends directly on claim 6 and so is patentable for at least the same reasons given above in Section A.2

Please note that new claim 15 is being presented to provide additional coverage for a device for directional attachment of a scale and so is not being presented for reasons of patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722 (2002).

CONCLUSION

In view of the arguments above, Applicants respectfully submit that all of the pending claims 1-15 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John C. Freeman", is written over a horizontal line.

John C. Freeman
Registration No. 34,483
Attorney for Applicants

BRINKS HOFER
GILSON & LIONE
P.O. Box 10395
Chicago, Illinois 60610
(312) 321-4200

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